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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,585	07/30/2001	Tian-Qiang Sun	PP-16093.002	2590

7590

10/01/2002

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EXAMINER

HUTSON, RICHARD G

ART UNIT PAPER NUMBER

1652

DATE MAILED: 10/01/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,585

Applicant(s)

SUN ET AL.

Examiner

Richard G Hutson

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to an isolated nucleic acid vector and host cells comprising said nucleic acid and methods of expression of said nucleic acid, classified in class 435, subclass 194.
- II. Claims 7, 8, 9, 11 and 12, drawn to kinase polypeptides, classified in class 435, subclass 194.
- III. Claim 10, drawn to an antibody against a kinase polypeptide, classified in class 530, subclass 387.1.
- IV. Claim 13, drawn to a method of identifying an inhibitor or an enhancer of PAR-1, classified in class 435, subclass 69.1.
- V. Claims 14-20, drawn to a PAR-1 modulator, classified in class 514, subclass 789.
- VI. Claims 21-25, drawn to a method of treating a mammal with a disease associated with PAR-1, comprising administering a PAR-1 modulator, classified in class 514, subclass 789.

For each of inventions I-VI above, restriction to one of the following is also required under 35 USC 121. Therefore, election is required of one of inventions I-VI and one of inventions (A)-(D).

- (A). SEQ ID NO: 1 or a sequence encoding SEQ ID NO: 3.
 - (B). SEQ ID NO: 4 or a sequence encoding SEQ ID NO: 6.
 - (C). SEQ ID NO: 7 or a sequence encoding SEQ ID NO: 9.
 - (D). SEQ ID NO: 10 or a sequence encoding SEQ ID NO: 12.
-

The inventions are distinct, each from the other because of the following reasons:

Inventions (A)-(D) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, represent structurally different polypeptides and the polynucleotides encoding them. Therefore, where structural identity is required, such as for hybridization or expression, the different sequences have different effects.

Inventions I-III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the nucleic acid of Group I, the polypeptide of Group II, the antibody of Group III and the PAR-1 modulator of Group V each comprise a chemically unrelated structure capable of separate manufacture, use and effect. The polypeptides of Groups I and III each comprise a different amino acid sequence and the nucleic acid of Group I is comprised of nucleic acid sequence. The Par-1 modulator of Group V is not defined structurally although may be an oligonucleotide, ribozyme, protein, polypeptide or small molecule, each of which is distinct from Groups I-III. The nucleic acid has other utility

besides encoding protein such as a hybridization probe, and the proteins can be made synthetically. Additionally, the proteins can be used to perform specific biological function(s) which are independent of the function(s) of the DNA molecule.

Inventions I and IV are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the nucleic acid of Group I can be used in a materially different process such as one in which the nucleic acid is used in a diagnostic hybridization assay.

The protein of Group II, the antibody of Group III, and the modulator of Group V are unrelated to the method of Group IV as they are neither used nor made by the method of Group IV.

Inventions V and VI are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the modulator of Group V can be used in a materially different process such as one in which the modulator is used in a method of characterizing the PAR-1 polypeptide and its interaction with other polypeptides.

The nucleic acid of Group I, the protein of Group II and the antibody of Group III, are unrelated to the method of Group VI as they are neither used nor made by the method of Group VI.

The methods of Groups IV and VI are independent as they comprise different steps, utilize different products and produce different results.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read 'Richard Hutson', with a long horizontal line extending to the right.

Richard Hutson, Ph.D.
Patent Examiner
Art Unit 1652
September 30, 2002